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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,739	06/26/2006	Yoshiaki Hashimoto	KUZ0032US.NP	5791

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EXAMINER	
ORWIG, KEVIN S	

ART UNIT	PAPER NUMBER
1611	

NOTIFICATION DATE	DELIVERY MODE
06/03/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

poreilly@licataandtyrrell.com

Office Action Summary	Application No.	Applicant(s)	
	10/584,739	HASHIMOTO ET AL.	
	Examiner	Art Unit	
	Kevin S. Orwig	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3, 7, and 11-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,7 and 11-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application.
6) ☐ Other: _____.

DETAILED ACTION

The amendments and arguments filed Mar. 15, 2010 are acknowledged and have been fully considered. Claims 1-3, 7, and 11-15 are now pending. Claims 4-6 and 8-10 are cancelled; claim 1 is amended; claims 12-15 have been added. Claims 1-3, 7, and 11-15 are now under consideration.

OBJECTIONS/REJECTIONS WITHDRAWN

The rejection of claims 4-6 under 35 U.S.C. 112, 1st paragraph, lack of written description, is moot in light of the claim cancellations.

The rejection of claims 1-3, 7, and 11 under 35 U.S.C. 103(a), over '819 and Tateishi, is withdrawn in light of the claim amendments in favor of the rejection including Honda presented below.

OBJECTIONS/REJECTIONS MAINTAINED

The rejection of claims 1-3, 7, and 11 under 35 U.S.C. 103(a) over TSURUDA and HONDA is maintained as discussed below.

The rejection of claims 1-3, 7, and 11 under 35 U.S.C. 103(a) over TSURUDA and YASUKOCHI is maintained as discussed below.

Claim Rejections - 35 USC § 103 (Maintained)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 7, 11 and new claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over TSURUDA (WO 01/68061; Published Sep. 20, 2001; Reference AC on IDS dated Aug. 3, 2006; U.S. Patent No. 6,924,410 is used herein

as an English language translation) (hereinafter Tsuruda) in view of HONDA (U.S. 5,637,293; Issued Jun. 10, 1997; of record).

Since the WO publication is in Japanese, the U.S. patent to Tsuruda, which is the result of the national stage entry of the international application, is relied upon herein as an English language equivalent for all rejections based on WO 01/68061. Column and line numbers refer to the '410 patent.

1. Tsuruda discloses patches comprising a backing (i.e. a support) and an adhesive base (abstract; col., line 59 to col. 2, line 11). Tsuruda teaches that the adhesive base of the patches may preferably comprise a styrene-isoprene-styrene block copolymer (i.e. a macromolecule having a double bond at least in a principle chain thereof (col. 7, lines 7-14; col. 9, lines 4-5 and 17-26). The amount of the styrene-isoprene-styrene copolymer is preferably 10-50% by mass based on the total amount of the base (col. 7, lines 62-67; col. 8, lines 1-12). Tsuruda also teaches the inclusion of a non-steroidal anti-inflammatory, drug (NSAID), most preferably ketoprofen (col. 5, line 15), in the adhesive base, preferably in an amount of 0.1-30% by mass, more preferably 0.1-16% by mass (col. 2, lines 38-41; col. 5, lines 15-22; col. 7, lines 50-54; Formulations 1, 4, and 7) in the patches of their invention. Tsuruda teaches the use of preferred tackifiers including hydrogenated rosin esters and terpene resins that may be used in combination in the adhesive base (col. 7, lines 21-24; col. 9, lines 27-45). Tsuruda teaches the use of tackifiers in an amount of 5-50%, more preferably 10-40% by mass relative to the total amount of the adhesive base (col. 9, lines 40-45), and teaches that the amount of tackifier can be used to regulate the viscosity and adhesive strength of

the base (col. 9, lines 40-45). Furthermore, Tsuruda teaches the use of an ultraviolet (UV) screening agent(s) (e.g., UVA blockers such as benzotriazole derivatives (col. 2, lines 23-24); and UVB blockers such as benzophenone derivatives (col. 2, lines 24-29)), as a stabilizer, in preferable amounts of 0.01-20% by mass (abstract; col. 2, lines 12-33; col. 3, lines 41-49). Additionally, Tsuruda teaches the use of a variety of benzotriazole derivatives and other known organic UV screening agents such as cinnamic acid derivatives and amino acid-based compounds (col. 2, lines 20-29; col. 2, line 46 to col. 3, line 35).

2. Thus, the only difference between Tsuruda and the instant claims is that Tsuruda does not teach the UV blocker in the adhesive base. However, Tsuruda clearly establishes that incorporating the UV absorbent into the base was common practice in the art at the time of the invention. Tsuruda states, "the means for keeping the stability of a medicine in patches has generally been to incorporate an ultraviolet absorbent into the base" (col. 1, lines 39-41). Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the UV blocker in the adhesive base as was common in the art. Based on the disclosure of Tsuruda as a whole, the artisan would readily envision doing so, particularly in light of the related art.

3. For instance, Honda discloses topical preparations for drug delivery useful as, *inter alia*, cataplasms and plasters comprising UV blocking agents (abstract; col. 4, lines 29-32). The UV blocking agents of Honda are incorporated into the epidermal preparation and thus contact the skin (i.e. they are not in a backing). In light of these teachings, it would have been *prima facie* obvious to one of ordinary skill in the art at

the time of the invention to place the UV blocking agent(s) taught by Tsuruda in the adhesive base as was well-known in the art at the time of the invention. Doing so amounts to routine rearrangement of parts, to provide a predictable result. Furthermore, one would be motivated to include the UV blocking agent in the base as opposed to the backing to avoid the potential of unwanted removal of the UV blocker from the backing by normal wear and abrasion. Claims 1-3, 7, and 11-15 are rendered obvious over Tsuruda and Honda.

4. The UV blocking agents taught by Honda include both dibenzoylmethane derivatives (col. 2, line 60) and benzotriazole derivatives (col. 2, lines 61-62). In particular, Honda teaches that either 4-*tert*-butyl-4'-methoxydibenzoylmethane (i.e. Avobenzone) (col. 2, line 61) or 2-(2-hydroxy-5-methylphenyl)benzotriazole (i.e. 2-(2'-hydroxy-5'-methylphenyl)benzotriazole), which is taught as an acceptable benzotriazole derivative by Tsuruda (Example 1) are acceptable UV blockers in these formulations. Thus, it is clear from the teachings of Honda that 4-*tert*-butyl-4'-methoxydibenzoylmethane and 2-(2'-hydroxy-5'-methylphenyl)benzotriazole are expected to function in the same way.

5. Since Tsuruda teach the use of 2-(2'-hydroxy-5'-methylphenyl)benzotriazole as a UVA blocker, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use 4-*tert*-butyl-4'-methoxydibenzoylmethane as a UV blocker in the patches of Tsuruda as both Tsuruda and Honda are directed to the same problem of blocking UV light in topical formulations. Because both compounds have the same function, the artisan would have had a high expectation of obtaining the

predictable results of blocking UV light in the topical composition with the 4-*tert*-butyl-4'-methoxydibenzoylmethane. Claim 5 is rendered obvious over Tsuruda and Honda.

6. Tsuruda teaches embodiments wherein the patches further contain zinc oxide (Example 10, wherein Formulation 6 comprises a styrene-isoprene-styrene block copolymer and a NSAID), reading on instant claim 11. Thus, claim 11 is rendered obvious over Tsuruda and Honda.

Response to Arguments

Applicants' arguments have been fully considered but are not persuasive. Applicants assert that the combination of references do not provide predictability with respect to the claimed invention (response, p. 7).

No evidence of unpredictability has been presented. MPEP 716.01(c) states: The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. Thus, applicants' unsupported argument is unpersuasive.

Applicants argue that Tsuruda teaches that safety is a concern when UV absorbents contact the skin (response, p. 8).

While safety may be a concern with some UV absorbents, there is nothing of

record to indicate that the claimed UV absorbent has such a problem. In fact, Honda expressly teaches the instantly claimed UV absorbent (i.e. 4-tert-butyl-4'-methoxydibenzoylmethane, or Avobenzone) in the adhesive base, which contacts the skin. Clearly, Honda did not share a concern over safety when Avobenzone contacts the skin.

Applicants argue that Honda teaches UV light absorbents can separate out in some preparations, a problem which Honda solved by adding certain components to the composition (response, p. 8).

Applicants' point in making this argument is unclear since the instant claims 1) do not exclude the components (e.g. kojic acid and fatty acid esters) used by Honda (the instant claims use the open "comprising" language) and 2) do not require that the UV absorbent be uniformly dispersed (i.e. not separate out of the preparation). Thus, even if, *in arguendo*, applicants provided evidence that Avobenzone would surely separate out of Tsuruda's preparations (which has not been done), that adhesive would still read on the instant claims, which only require that Avobenzone be present in the base.

Applicants argue that the references were not considered as a whole and that Honda is unrelated to transdermal patches with adhesive bases, and requires agents not required by the instant claims (response, p. 11).

The references were considered as a whole. As a whole the references establish the obviousness of placing the UV absorbent in the base of an adhesive patch. As stated above, the instant claims utilize the open "comprising" language, which is inclusive to the components required by Honda. Applicants are apparently

arguing that Honda is non-analogous art. In response to applicants' argument that Honda is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Honda is both in the field of applicants' endeavor, namely stable drug-containing patch preparations (Honda teaches their use as cataplasms and plasters) for skin that use UV absorbents, and pertinent to the problem with which applicant is concerned, namely the use of UV absorbents to stabilize topical skin patch preparations. Simply claiming a specific known UV absorbent is not sufficient to overcome the vast amount of art available in this field.

Applicants submit a declaration by one of the co-inventors listed on the instant application in support of their assertion of unexpected results (response, p. 12).

This declaration is unpersuasive for at least the reason that it does not sufficiently compare the instant invention to the closest prior art. All the declaration shows is that Avobenzone, a well-known and highly efficient UVA/UVB absorber, suppressed ear swelling in mice to a greater extent than a single undefined hydroxybenzotriazole derivative. Given that these compounds belong to different classes of UV absorbents (e.g. dibenzoylmethane, and hydroxybenzotriazole) it is not surprising (i.e. it is completely expected) that there may be differences in their behavior and efficiency. However, that does not take away from the fact that the prior art teaches both types of these compounds as suitable choices for the same use as instantly

claimed. The prior art recognizes a variety of UV absorbents, and it is well within the purview of the skilled artisan to select the appropriate type depending on the desired specification and intended use of the final product. The artisan would take into account the differences in each UV absorbent compound as a matter of routine practice. The prior art teaching does not have to indicate that all the compounds would have the exact same efficiency at a given level, nor would such ever be expected by a skilled artisan. Rather, the prior art indicates that a variety of known UV absorbers are all suitable for the same purpose despite the differences in their structure and properties. Moreover, given that the identity of the hydroxybenzotriazole derivative was not disclosed in the declaration, no proper comparison can be made to what is taught by the prior art. It is not even certain that the hydroxybenzotriazole derivative compared in the declaration is even among the many compounds taught in the prior art. No persuasive evidence of unexpected results has been provided.

Claims 1-3, 7, 11, and new claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuruda in view of YASUKOCHI (U.S. 2005/0053646; Filed Jan. 24, 2003; of record).

7. The teachings of Tsuruda are presented *supra*. Tsuruda discloses that it was common practice to incorporate a UV absorbent into the base of a patch (col. 1, lines 39-41), but does not explicitly embody the use of UV blocking agents in the adhesive base *per se*.

8. Yasukochi discloses patches comprising pressure sensitive adhesives (abstract). Yasukochi teaches that the adhesives of these patches may contain a variety of

additives including UV-absorbing agents (par. [0048]). Yasukochi teaches that these UV-absorbing agents can be used in amounts of 15 wt % or less, preferably 10 wt % or less relative to the total weight of the adhesive composition (par. [0048]).

9. It is noted that inclusion of the UV screening agent in either the backing or the adhesive base of the patch would have the same stabilizing effect on both the pharmaceutical compound and the rubber-system macromolecules in the adhesive base. Furthermore, adhesive bases comprising UV absorbing agents were known in the art at the time of the invention. Thus, placing the UV blocker in the adhesive base would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention based on the teachings of Tsuruda and Yasukochi. The artisan would have had a high expectation for obtaining the predictable result of preventing UV damage to the skin, pharmaceutical compound, and/or adhesive by including the UV-blocking compound in the adhesive base in an amount of 10% or less. Claims 1-3, 7, and 11-15 are rendered obvious over Tsuruda and Yasukochi.

Response to Arguments

Applicants' arguments have been fully considered but are not persuasive. Applicants assert that Yasukochi is not predictive of safety, solubility, and/or separation of Avobenzone (response, p. 9).

As discussed above, no evidence of unpredictability has been presented. See MPEP 716.01(c). Moreover, in response to applicants' argument that the references fail to show certain features of applicants' invention, it is noted that the features upon which applicant relies (i.e., safety, solubility, and/or separation of Avobenzone) are not recited

in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, The MPEP states, "Obviousness does not require absolute predictability, however, at least some degree of predictability is required." See MPEP § 2143.02(II). The cited references establish at least a reasonable expectation of success (i.e. predictability).

Applicants argue that the references were not considered as a whole and that Yasukochi is unrelated to transdermal patches (response, pgs. 11-12).

The references were considered as a whole. As a whole the references establish the obviousness of placing the UV absorbent in the base of an adhesive patch. As stated above, the instant claims utilize the open "comprising" language, which is inclusive to the components required by Yasukochi. Applicants are apparently arguing that Yasukochi is non-analogous art. In response to applicants' argument that Yasukochi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Yasukochi is both in the field of applicants' endeavor, namely adhesive transdermal patches, and pertinent to the problem with which applicant is concerned, namely the use of UV absorbents to stabilize topical skin preparations. Simply claiming an amount of a known UV absorbent is not sufficient to overcome the vast amount of art available in this field.

Claims 1-3, 7, 11, and new claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2003/0109819 (Filed Dec. 15, 2000) (hereinafter '819) in view of TATEISHI (WO 03/037393; Published Aug. 5, 2003; U.S. 2005/0042269 used as an English translation; of record) and Honda.

Since the WO publication is in Japanese, the U.S. patent application to Tateishi, which is the result of the national stage entry of the international application, is relied upon herein as an English language equivalent for all rejections based on WO 03/037393. Paragraph numbers refer to the '393 application.

10. '819 discloses a patch comprising a styrene-isoprene-styrene block copolymer in an amount of 10-50% by mass, tackifier, and drug (abstract; par. [0015]). The patches comprise a support (pars. [0027]-[0029]; Examples 2 and 5) and an adhesive base (pars. [0008], [0010], and [0021]; claim 1). NSAIDs may be present in amounts from 0.001 to 30% by mass (par. [0026]) and ketoprofen is exemplified at a level of 4% (Example 2). '819 teaches blending a UV-ray absorbent such as benzophenone or benzotriazole derivatives, into the composition (i.e. the adhesive base) as necessary (pars. [0014] and [0031]). The tackifier is a rosin ester, hydrogenated rosin ester, maleic acid modified rosin ester, terpene, or petroleum resin and one or more of these may be blended, preferably in an amount from 10-40% by mass (par. [0024]). Thus, the only difference between '819 and instant claim 1 is that '819 does not disclose the *percentage* of UV absorbent useful in the invention.

11. It is noted that it is well within the purview of the ordinary artisan to optimize the concentration of a result-effective component (such as the UV absorbent of '819) with

no more than routine experimentation. Nonetheless, Tateishi discloses patches having UV absorbers incorporated in the adhesive base layer of the patch and teaches that these components are suitably added in the range of not more than 10% wt % (pars. [0043] and [0044]). Thus, the artisan would have been guided by the art to use a UV absorber in this range.

12. '819 teaches the use of 2-(2-hydroxy-5-methylphenyl) benzotriazole, but not the related methoxy derivative. However, the use of related benzotriazole derivatives would have been obvious to an ordinary artisan. For example, Honda discloses the use of both 4-tert-butyl-4'-methoxydibenzoylmethane (instantly claimed) and benzotriazole derivatives such as 2-(2-hydroxy-5-methylphenyl)benzotriazole as taught by Tateishi. Thus, the prior art establishes these compounds as functional equivalents and their substitution for one another is *prima facie* obvious. Claims 1-3, 7, and 11-15 are rendered obvious over '819 and Tateishi. is rendered obvious over '819, Tateishi, and Honda.

13. Both '819 (par. [0031]; Examples 5 and 6) and Tateishi (par. [0043]) teach the use of zinc oxide, rendering claim 11 obvious.

Response to Arguments

Applicants' arguments have been fully considered but are not persuasive. Applicants assert that '819 and Tateishi are not predictive of safety, solubility, and/or separation of Avobenzone (response, p. 9).

As discussed above, no evidence of unpredictability has been presented. See MPEP 716.01(c). Moreover, in response to applicants' argument that the references fail

to show certain features of applicants' invention, it is noted that the features upon which applicant relies (i.e., safety, solubility, and/or separation of Avobenzone) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, The MPEP states, "Obviousness does not require absolute predictability, however, at least some degree of predictability is required." See MPEP § 2143.02(II). The cited references establish at least a reasonable expectation of success (i.e. predictability).

It is noted that the prior art teaches the use of a combination of hydrogenated rosin ester and terpene resin in the instantly claimed % range. For example, '819 teaches that preferable tackifiers include, *inter alia*, hydrogenated rosin esters and terpene resins and teaches that one or more of these resins may be blended, preferably in an amount from 10-40% by mass (par. [0024]). Additionally, Tsuruda (WO 01/68061) teaches this limitation as well (see col. 9, lines 27-45 of 6,924,410). Both of these references teach that the content of the tackifier can be used to regulate the viscosity and adhesive strength of the base (see '819 paragraph [0024]; and col. 9, lines 40-45 of 6,924,410). Thus, the artisan would have expected to optimize this result-effective parameter. Further, applicants own specification does not indicate that the range of 10-20% is CRITICAL; it is merely a preferred embodiment. In fact, par. [0047] of the pre-grant publication states that the amount of tackifier is preferably 3-50% mass % relative to the total amount of the base, more preferably 5 to 45 mass %, and yet more preferably 7 to 40 mass %, and the viscosity and the adhesive strength of the base are

adjusted so as to be in the above-mentioned ranges. This is precisely what is taught by the prior art. Apparently all that applicants have done is optimize the amount of tackifier based on the teachings of the prior art. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

In total, applicants have not sufficiently distinguished the claimed invention from the prior art to overcome the rejections of record and have not sufficiently rebutted the *prima facie* case of obviousness established by the Office.

Regarding the obviousness rejections herein, it is noted that a reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

Summary/Conclusion

Claims 1-3, 7, and 11-15 are rejected; claims 4-6 and 8-10 are cancelled.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Orwig whose telephone number is (571)270-5869. The examiner can normally be reached Monday-Friday 7:00 am-4:00 pm (with alternate Fridays off). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached Monday-Friday 8:00 am-5:00 pm at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin S Orwig/

/Sharmila Gollamudi Landau/
Supervisory Patent Examiner, Art Unit 1611